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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/131,076 08/07/98 KLIGMAN

D 6149-29-U1

000570 HM12/0702
AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA PA 19103

EXAMINER

TRANS

ART UNIT

PAPER NUMBER

1615

DATE MAILED:

07/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/131,076

Applicant(s)

Kligman et al.

Examiner

Susan Tran

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on May 14, 2001

2a) ☐ This action is **FINAL**.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-14 and 20-22 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-7, 11-14, and 20-22 is/are rejected.

7) ☒ Claim(s) 8-10 is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 20

20) ☐ Other:

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DETAILED ACTION

Receipt is acknowledged of applicants Petition for Extension of Time filed on 11/20/98, Declaration and Fee filed 02/01/99, Petition filed 02/01/99, Request for Corrected Filing Receipt filed 03/22/99, Information Disclosure Statement filed 08/07/98, Request for Extension of Time filed 1/31/00, and Preliminary Amendment A filed 1/31/00, Request for Extension of Time filed 07/26/00, 02/05/01, and 05/14/01, Request for Reconsideration filed 07/26/00, Supplemental Information Disclosure Statement filed 09/15/00, Notice of Appeal filed 02/05/01, Request for Continued Examination filed 05/4/01, Declaration filed 05/14/01, and Preliminary Amendment B filed 05/14/01.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 11, 12, and 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Blank WO 93/10756.

Blank teaches a method for regulating wrinkles by topically applying to the skin a composition comprising of an effective amount of salicylic acid in ethanol solution (pages 2-4, and 6). The concentration of salicylic acid can range from 0.01% to 50% (see claim 2).

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blank, in view of Damani et al US 4,514,385.

Blank is relied upon for the reasons stated above. The reference is silent as to the teaching of salicylic acid for the treatment of acne.

Damani teaches a composition comprising from about 0.1% to about 25% salicylic acid for the treatment of acne (column 2, lines 49 through column 3, lines 1-2). Thus, it would have been prima facie obvious for one of the ordinary skill in the art to modify Blank's composition for the treatment of skin acne in view of the teaching of Damani. The reason for this modification is to obtain a composition including up to 50% salicylic acid that is safe and useful for the treatment of skin wrinkles, acne, or other skin related conditions.

2. Claims 1-6, 11, 12, and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blank. The examiner relies on the following 103(a) rejection in the case that applicant will overcome the above 102(b) rejection.

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Blank is relied upon for the reasons stated above. It would have been obvious that salicylic acid at a concentration of up to 50% is safe and useful for the treatment of the skin.

3. Claims 7-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Amendment

4. The Declaration under 37 CFR 1.132 filed 05/14/01 is sufficient to overcome the rejections of claims 1-7, 11-14, and 20-22 based upon Kligman US 4,318,907 and Rapaport US 5,730,991.

The Declaration has been considered but found unpersuasive because the Declaration is directed to salicylic acid having concentration of 30% is not patentable over Blank. Blank recognized the use of salicylic acid in a concentration of from about 0.01% to 50% that is safe and effective for topical application to the skin. Accordingly, applicant obtain no unexpected results over the teaching of the prior art.

Pertinent Arts

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wagner et al., and McCook et al. are cited as being of interest for the teaching of up to 20% salicylic acid in topical composition for treatment of skin.

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Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Tran whose telephone number is (703) 306-5816. The examiner can normally be reached on Monday to Thursday from 6:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.


THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600